



**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Per MANSSON et al. Confirmation No: 3651  
Appl. No. : 10/517,321  
Filed : August 23, 2005  
Title : SYSTEM, DEVICE AND METHOD FOR DETECTION  
OF SEVERAL INDIVIDUAL ANALYTES IN A SOLUTION,  
AND A DISPOSABLE FLOW CELL FOR USE THEREIN

TC/A.U. : 1641  
Examiner : U. Jung

Docket No.: : MANS3012/REF  
Customer No: : 23364

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a request for review of the final rejection of October 19, 2007, in connection with the above identified application. The period for response to this final rejection has been extended to expire on February 19, 2008, by the filing herewith of a petition for a one month extension of time and payment of the required fee.

Applicants request review of the final rejection of October 19, 2007, in the above identified application.

No amendments are being filed with this request.

The review is requested for the reasons stated in the attached paper containing no more than five pages.

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Request dated: February 19, 2008  
Reply to OA of: October 19, 2007



A notice of appeal is filed concurrently herewith.

Respectfully submitted,

BACON & THOMAS, PLLC

By: Richard E. Fichter  
Richard E. Fichter  
Registration No. 26,382

625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080

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Pre appeal brief review.wpd

February 19, 2008



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**REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The statement of the holding in *Nerwin v. Erlichman*, 168 USPQ 177, 179 is in error

The rejection of claim 10 as being obvious over Kawakami, and Luscher, includes the premise that constructing a formerly integral structure in various elements involves only routine skill in the art. This is based on *Nerwin v. Erlichman*, 168 USPQ 177, 179, which is a Board of Appeals decision in an interference and involves no such holding. In fact, the term "routine skill in the art" is not found in any portion of the decision. Headnote [4] of the decision states that the mere fact that a given structure is integral does not preclude its consisting of various elements for support of a count in an interference. This is completely different from a holding that constructing a formerly integral structure in various elements involves only routine skill which is in clear error.

There are two issues here, firstly, Kawakami fails to disclose a detachable flow-through cells and secondly, Kawakami fails to disclose individual flow-through cells. The citation to *Nerwin* appears to address the issue of the separating the integral flow-through cells shown in Kawakami to result in individual flow-through cells, but Applicants respectfully submit that the cited case law has no effect whatsoever on

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whether the flow-through cells would be detachable. As shown in Figure 9, a clamp 90 is used to hold the lower member 10 and the upper member 30 together. Thus, even if the flow-through cells are individual flow-through cells, the clamp 90 will still make the upper member 30 non-detachable from the lower member 10. See also the discussion beginning on page 5, third full paragraph and carrying over to page 6, inclusive of the penultimate paragraph, of Applicants response filed on August 3, 2007.

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, as in the present case the individually detachable cells, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

In this regard, the Final Rejection relies upon (Making Separable), *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."). The facts with respect to the relationship of the prior art to the claimed invention in the present application are not sufficiently similar to those in the *Dulberg* decision for it to be controlling of obviousness of the presently claimed invention and reliance thereon is in error. Moreover, there is no reason suggested in the prior art to the claimed invention which includes a plurality of individually detachable microbalances.

The statement of the rejection with respect to the teachings of the Kawakami et al reference appears to be in clear error.

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The connecting station 100 and 101 referred to in item 7 of the Final Rejection is actually referred to at column 6, line 30 of the patent as a flow cell 100 comprising an upper member 20, an outer seal member 30, cell compartment seal members 40 and plate-shaped quartz oscillators 50. Moreover, elements 63 and 64 in Figure 9 are tubes and not piezoelectric crystal micorbalances as stated in the rejection. This portion of the rejection is in clear error.

Similarly, the identification of reference elements 10 in Fig 6 on page 4 of the rejection is in clear error. As clearly stated at column 2, line 13, Fig 6 is a plane view of the lower member, which is the lower member 10 of the flow cell 100. It cannot be reasonably construed as a connecting panel as set forth in the rejection and as related to the presently claimed invention. Specifically, Applicants respectfully submit that Kawakami fails to disclose (1) a plurality of individually detachable piezoelectric crystal microbalance flow-through cells and (2) a pair of fluid connecting ports in the connector portions of the connecting panel. Moreover, reference elements 11a-11c in Fig 6 are circular pits in the lower portion 10 of the flow cell 100 and not cell connector portions in accordance with the presently claimed invention and such interpretation to the contrary represents a clear error.

The rejection states that "upon plugging the flow through cell, 10, (previously identified in the rejection as a connecting panel) into the connecting station is clearly in error as contrary to the clear teaching of the patent at column 6, line 2, "...and the upper and lower member 10, 20 are clamped with the metal clamp 90 to complete assembly of the flow cell. As shown in, e.g., Figures 2 and 3 of the instant application, the flow-through cells of the instant application comprise both a first half 14 and a second half 16. Then, as shown in Figure 8, the flow-through cell 10 comprising a first half and a second half 20 is placed in the cell connecting receptor of the connecting panel 112. The flow through cell and the connecting panel are clearly separate elements. In fact, the detachability of the flow-through cells depends on the flow through cells having a housing separate of the connecting panel which is clearly not shown or suggested to one skill in the art by the primary reference.

However, Applicants note that the Final Rejection also alleges that the lower member 10 corresponds to the connecting panel recited in claim 10 of the instant

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application. Thus, the Official Action appears to allege that the lower member 10 serves the dual purpose of serving as the connecting panel and the bottom portion of the flow-through cells. Such an interpretation is clearly contrary to what is disclosed and claimed in the instant application.

Applicants have not interpreted that element 10 of Figures 2 and 3 represent a connecting panel other than to assert that that is an incorrect position held in the final rejection. At page 12 of the final rejection it is stated that the bottom of the flow-through cell is not represented by element 10 of Figures 2 and 3 but rather by 50a. This is contrary to any reasonable interpretation of the reference which at column 6 lines 4 and 5 states here, the areas defined by the plate-shaped quartz oscillators 50a-50c and not at as the bottom of the flow-through cells as stated in the Official Action. Moreover, in the same paragraph these elements are stated to be oscillators (50a-50c). Clearly, one of ordinary skill in the art would not interpret the teaching of the reference as set forth in the final rejection which is not an anticipation rejection but on the grounds of obviousness. Clearly the final rejection relies upon Applicants teaching to interpret the primary reference to meet the requirements Applicants claimed invention and contrary to an understanding of the reference by one of ordinary skill in the art to which the invention pertains.

Assuming Kawakami is interpreted such that the lower member 10 is the flow-through cell recited in claim 10, then Kawakami fails to disclose a connecting panel as recited in claim 10. Assuming Kawakami is interpreted such that the lower member 10 is the connecting panel recited in claim 10, the Kawakami fails to disclose a flow through cell. The bottom of the alleged flow-through cells would be the plate-shaped quartz oscillators 50. This configuration would clearly fail to disclose a flow-through cell as the term is used in the instant application, because the flow-through cell would not comprise a unit which encases the piezoelectric crystal microbalances.

Therefore, since there is no reasonable interpretation of Kawakami in which the reference may be deemed to disclose a flow-through cell and a connecting panel, where the flow-through cell and the connecting panel are separate elements, Applicants respectfully submit that the Kawakami reference fails to disclose the elements of the claims which the Official Action alleges are disclosed in the reference.

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The teaching of the primary reference does not teach the claimed invention except for the detachable microbalance flow through cells for the reasons discussed above and in the previous responses. Moreover, there is nothing to suggest to one of ordinary skill in the art to make the flow through cell of Kawakami with a single cell to arrive at the present invention. Even under KSR, one cannot use impermissible hindsight to reconstruct the claimed subject matter from the prior art reference.

The teaching of the secondary references in the remaining rejections do not overcome the deficiencies of the primary reference for the reasons discussed above. Accordingly, these rejections should be withdrawn.

The Provisional Obviousness Double Patenting Rejections have been requested to be held in abeyance as there is no indication of allowable subject matter of the relevant claims in any application. It is further noted that a timely filed Terminal Disclaimer will obviate these provisional rejections. Alternatively, cancellation of the subject claims from one of the applications will avoid the rejections. Appropriate action will be taken once the provisional nature of the rejections is removed.

In view of the above comments, favorable reconsideration and allowance of all the claims now present in the application are most respectfully requested.

Respectfully submitted,  
BACON & THOMAS, PLLC

By:   
Richard E. Fichter  
Registration No. 26,382

625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080

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